

Declaration should be withdrawn. Applicants respectfully request reconsideration and withdrawal of the objection.

The disclosure is objected to because "the status of the parent application needs to be updated on page 1". To obviate this objection, the specification is amended. Thus, the objection to the disclosure should be withdrawn. Applicants respectfully request reconsideration and withdrawal of the objection.

Claim 29 is rejected under 35 U.S.C. §112, first paragraph because the limitation "2 to 10 nm" in line 2 of Claim 29 is not supported by the specification. To obviate this rejection, Claim 29 is amended to recite --2 to 10 mm--, as supported by the specification at page 13, lines 18-19. Applicants submit that Claim 29 meets the requirements of 35 U.S.C. §112, first paragraph. Therefore, the rejection of Claim 29 under 35 U.S.C. §112, first paragraph, should be withdrawn. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 12-36 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite because assertedly there is insufficient antecedent basis in independent Claims 12 and 21 for the limitation "the main component". Applicants respectfully traverse this rejection because "the main component" has inherent antecedent basis in the recited "target material". See, MPEP §2173.05(e). The word "main" can be defined as "most important; principal". The American Heritage College Dictionary, 3rd edition., page 817, copy attached. The term "principal" can be defined as "first, highest, or foremost in importance, rank, worth, or degree;". Id, page 1088, copy attached. Because there can be only one "main component" of the recited "target material", the limitation "the main component" has inherent antecedent basis in the recitation of "target material". Thus, Applicants submit that Claims 12 and 21 meet the requirements of 35 U.S.C. §112, second paragraph. Applicants thank the Examiner

for the indication that the rejection under of 35 U.S.C. §112, second paragraph, is withdrawn.

Interview Summary dated May 24, 2001.

Claims 12-20 are rejected under 35 U.S.C. §102(a) over JP 7-233469 (JP-469).

Applicants respectfully traverse this rejection because JP-469 is not prior art under 35 U.S.C. §102(a) to Claims 12-20. In particular, Claims 12 and 15-17 are the invention of the three of the present inventors who authored JP-469, but are not the invention of the other present inventors. In addition, Claims 13-14 and 18-20 are entitled to a priority date earlier than the publication date of JP-469.

Under 35 U.S.C. §102(a), a person shall be entitled to a patent unless the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the Applicant or patent.

Applicants' disclosure of their own work within the year before the application filing date cannot be used against them under 35 U.S.C. §102(a). MPEP §2132.01.

JP-469 was published on September 5, 1995, less than one year before the March 25, 1996, international filing date of the above-identified application. JP-469 is authored by Akira MITSUI, Takuji OYAMA and Kenichi SASAKI.

As shown on the attached Declaration Under 37 C.F.R. §1.132, Claims 12, 15-17, 21 and 31-33 are the invention of Akira MITSUI, Takuji OYAMA and Kenichi SASAKI. However, Claims 12, 15-17, 21 and 31-33 are not the invention of Otojiro KIDA, Eri SUZUKI, Hisashi OSAKI, and Atsushi HAYASHI.

Because the authorship of JP-469 is identical to the inventive entity of Claims 12 and 15-17, JP-469 is not a publication of the invention of Claims 12 and 15-17 before the invention thereof by Applicants. Thus, JP-469 is not prior art under 35 U.S.C. §102(a) to independent Claims 12 and 15-17.

Claims 13-14 and 18-20 are entitled to the priority of JP 7-215074 of August 23, 1995. To perfect Applicants' claim to priority under 37 C.F.R. 1.55, an English-language translation of the JP 7-215074 priority document is attached. Because the August 23, 1995, priority date of Claims 13-14 and 18-20 is before the September 5, 1995, publication date of JP-469, JP-469 is not prior art to Claims 13-14 and 18-20.

Because JP-469 is not prior art to Claims 12 and 15-17, or to Claims 13-14 and 18-20, the rejection of Claims 12-20 under 35 U.S.C. §102(a) over JP-469 should be withdrawn. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 12-15 and 18-19 are rejected under 35 U.S.C. §102(a) over WO 97/25450 ("Vanderstraeten"). In addition, Claims 12-15 are rejected under 35 U.S.C. §102(a) over WO 97/25451 ("Vanderstraeten II"). Applicants respectfully traverse these rejections because Vanderstraeten and Vanderstraeten II are not prior art to the above-identified application. Both Vanderstraeten and Vanderstraeten II were published on July 17, 1997, after the March 25, 1996, international filing date of the parent of the above-identified application. Applicants claim the priority of parent International Application No. PCT/JP96/00767 of March 25, 1996. See attached Declaration filed March 12, 1998, in parent U.S. Application No. 09/011,749. Because the above-identified application is entitled to the priority date of March 25, 1996, Vanderstraeten and Vanderstraeten II are not prior art to the above-identified application. Therefore, the rejections under 35 U.S.C. §102(a) over Vanderstraeten and over Vanderstraeten II should be withdrawn. Applicants respectfully request reconsideration and withdrawal of the rejections.

Claims 21-28, 30-34 and 36 are rejected under 35 U.S.C. §103(a) over JP-469 in view of U.S. Patent No. 5,354,446 ("Kida-446"). Applicants respectfully traverse this rejection because, JP-469 is not prior art to the claimed invention. In particular, Claims 21 and 31-33

are the invention of the three of the present inventors who authored JP-469, but are not the invention of the other present inventors. In addition, Claims 22-28, 30, 34 and 36 are entitled to a priority date earlier than the publication date of JP-469.

As discussed above, the attached Declaration Under 37 C.F.R. §1.132 shows that JP-469 is not prior art under 35 U.S.C. §102(a) to Claims 21 and 31-33.

Claims 22-28, 30, 34 and 36 are entitled to the priority of JP 7-215074 of August 23, 1995. As discussed above, to perfect Applicants' claim to priority under 37 C.F.R. 1.55, an English-language translation of the JP 7-215074 priority document is attached. Because the August 23, 1995, priority date of Claims 22-28, 30, 34 and 36 is before the September 5, 1995, publication date of JP-469, JP-469 is not prior art to Claims 22-28, 30, 34 and 36.

Because JP-469 is not prior art to Claims 21 and 31-33, or to Claims 22-28, 30, 34 and 36, the rejection of Claims 21-28, 30-34 and 36 under 35 U.S.C. §103(a) over JP-469 in view of Kida-446 should be withdrawn. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 21-28, 30-31 and 34-36 are rejected under 35 U.S.C. §103(a) over Vanderstraeten in view of Kida-446. As discussed above, Vanderstraeten is not prior art under 35 U.S.C. §102(a) to the above-identified application. Thus, Vanderstraeten in view of Kida-446 fails to have rendered obvious the claimed invention. Therefore, the rejection under 35 U.S.C. §103(a) over Vanderstraeten in view of Kida-446 should be withdrawn. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 21-28, 30-31 and 34-36 are rejected under 35 U.S.C. §103(a) over Vanderstraeten II in view of Kida-446. As discussed above, Vanderstraeten II is not prior art to the above-identified application under 35 U.S.C. §102(a). Thus, Claims 21-28, 30-31 and 34-36 are patentably distinguishable over Vanderstraeten II in view of Kida-446. Therefore,

the rejection of under 35 U.S.C. §103(a) over Vanderstraeten II in view of Kida-446 should be withdrawn. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 12, 14, 16, 21-22, 30, 32 and 34-36 are rejected under the judicially created doctrine of obviousness-type double patenting over Claims 2, 5, 10-13 and 16 of U.S. Patent No. 6,193,856. In addition, Claims 23-29 are rejected under the judicially created doctrine of obviousness-type double patenting over Claims 2, 5, 10-13 and 16 of U.S. Patent No. 6,193,856 in view of Kida-446. Furthermore, Claims 13, 15, 17-20, 31 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting over Claims 2, 5, 10-13 and 16 of U.S. Patent No. 6,193,856 in view of JP-469. To obviate these rejections, a Terminal Disclaimer over U.S. Patent No. 6,193,856 is attached. Thus, the obviousness-type double patenting rejections should be withdrawn. Applicants respectfully request reconsideration and withdrawal of the rejections.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance. Applicants respectfully request favorable consideration and prompt allowance of the application.

Should the Examiner believe that anything further is necessary in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Corwin P. Umbach, Ph.D.
Registration No. 40,211

Attachments:

Marked-up copy of amendments

The American Heritage College Dictionary, 3rd Edition, pp. 817 and 1088
Declaration filed March 12, 1998, in parent U.S. Application No. 09/011,749

Declaration Under 37 C.F.R. §1.132

English-language translation of JP 7-215074 priority document

Terminal Disclaimer over U.S. Patent No. 6,193,856



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(703) 413-3000

Fax #: (703) 413-2220

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